



PATENT APPLICATION
Mo5845
LeA 32,871

#221F
WD
5/27/13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN APPLICATION OF)
MARKUS WEISBECK ET AL) GROUP NO: 1754
SERIAL NO.: 09/601,152) EXAMINER: E. M. JOHNSON
FILED: SEPTEMBER 5, 2000) RESPONSE TO PAPER NO. 19
TITLE: METHOD FOR REGENERATING)
SUPPORTED CATALYSTS)
COVERED WITH GOLD)
PARTICLES AND USED FOR)
OXIDIZING UNSATURATED)
HYDROCARBONS)

RESPONSE AND AMENDMENT

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

This response is filed in reply to the Office Action mailed January 17, 2003 in the above-captioned matter and setting a three (3) month shortened statutory period for reply up to and including April 17, 2003.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on 4/08/03

Date

John E. Mrozinski, Jr., Reg. No. 46,179

Name of applicant, assignee or Registered Representative

Signature

April 8, 2003

Date

REMARKS

In the Notice of Non-Compliant Amendment mailed April 22, 2003, Supervisory Legal Instruments Examiner Palestine Jenkins checked box numbered 3, indicating that the claims of the amendment paper (filed April 8, 2003) were not presented in ascending numerical order. Applicants' attorney telephoned Ms. Jenkins on April 29, 2003 and May 12, 2003 and left voice mail messages requesting Ms. Jenkins return his call regarding this application. Although Ms. Jenkins did not return the calls, another individual from the Office did and contended that there were now two claims numbered 13 in the case as the response after final had been entered in the case. Applicants respectfully disagree with the Office's position.

The instant application, as filed July 27, 2000, had 5 claims, which were cancelled by preliminary amendment filed simultaneously therewith. That same preliminary amendment added Claims 6-11.

An amendment was filed February 6, 2002 in reply to the Office Action mailed November 11, 2001. That amendment added Claim 12.

An amendment after Final, submitted August 23, 2002, attempted to add Claim 13 to the application. In the Advisory Action, mailed October 16, 2002, the Examiner stated that the response after Final would not be entered as it raised new issues requiring a further search and/or consideration. Therefore, no Claim 13 was added to the application at that time. Applicants attach hereto a copy of that Advisory Action highlighted to show that the response after Final was not entered.

Applicants filed an RCE amendment on December 19, 2002, which cancelled Claim 12 and added Claim 13.

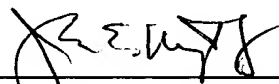
The amendment filed April 8, 2003 contains an argument, at page 3, 3rd paragraph, detailing the above in a more condensed form in reply to the Examiner's §112 rejections.

Conclusion

Applicants respectfully request Examiner P. Jenkins remove her holding of non-compliance of the amendment filed April 8, 2003 and forward the same (a copy of which is attached for the Examiner's convenience) to the Examiner in charge of the instant application.

Respectfully submitted,

By



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JM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,152	09/05/2000	Markus Weisbeck	MO-5845/LEA3	6993

157 7590 10/16/2002

BAYER CORPORATION
PATENT DEPARTMENT
100 BAYER ROAD
PITTSBURGH, PA 15205

DU
DOCKETED
BY RT 10/23/02
DATE Already Docketed for
APPROVED Appeal Brief 12/22/02

EXAMINER

JOHNSON, EDWARD M

ART UNIT PAPER NUMBER

1754

13

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

OCT 22 2002
RECEIVED

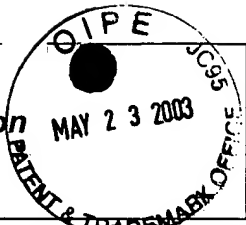
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MAY 27 2003

TC 1700

Pm
10/24

Advisory Action



Application No.

09/601,152

Examiner

Edward M. Johnson

Applicant(s)

WEISBECK ET AL.

Art Unit

1754

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 6-12.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Stamp: **RECEIVED**
MAY 27 2003
TC 1700

Continuation of 2. NOTE: Proposed new claim 13, which would replace the instant claim 7, includes regeneration with a dilute acid having a pH of 5.5-6.0, the entirety of which is a new issue requiring further search and/or consideration. Also, the proposed amendment to claim 11 would transform the claim into a Jepson claim, creating a new issue that would require further search and/or consideration. Finally, the amendment to claims 8 and 9 to regenerate the activity of the catalyst rather than the catalyst itself would also be a new issue requiring further search and/or consideration.

Continuation of 5. does NOT place the application in condition for allowance because: It is argued that in regard to claims 6 and 9-1, Muller et al. disclose a catalyst which is composed of titanium or vanadium silicalite -and one or more platinum metals-. Applicant claims gold particles and Muller discloses a catalyst with a gold modifier (see column 4, lines 33-36). Applicant does not appear to respond to the particular citation by the Examiner, instead focusing on a different disclosure of "platinum metals" found in column 1 and the possibility of gold in column 2. It is argued that it is important to note that there is an "inherent mystery" surrounding the unpredictability of the performance of catalysts. It is further noted that the instant method claim recites catalyst product limitations in the preamble. A preamble generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478 481 (CCPA 1951). It is argued that in order to "arrive at" Applicants' claimed invention, the skilled artisan would have had to ignore the fact that Muller et al. do not even teach or motivate the skilled artisan. This is not persuasive because Applicant appears to admit that Muller discloses titanium silicalite, which is an oxide, and gold; and Applicant claims titanium oxide and gold. Finally, Applicant appears to object to the broad disclosure of different embodiments in Muller. However, it is noted that Applicant also claims various catalysts with open claim language "comprising" wherein the catalyst includes gold and titanium dioxide which may or may not be hydrous. Because of the use of open claim language, embodiments containing other metals are not excluded by the claim. Therefore, contrary to Applicant's apparent suggestion, Applicant's claim is not considered to be far more limited in scope than the disclosure of Muller.